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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,478	09/15/2003	Rakesh Tuli	Q-75484	9837

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EXAMINER
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JOIKE, MICHELE K

ART UNIT	PAPER NUMBER
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1636

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/20/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/661,478

Applicant(s)

TULI ET AL.

Examiner

Michele K. Joike, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20-52 is/are pending in the application.
- 4a) Of the above claim(s) 22-25, 27, 28, 30-46 and 48-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20, 21, 26, 29 and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 09/15/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group I in the reply filed on September 18, 2006 is acknowledged.

Claims 22-25, 27-28, 30-46 and 48-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 18, 2006. Claims 20, 21, 26, 29 and 47 are examined.

### ***Claim Objections***

Claim 20 is objected to because of the following informalities: The claim contains nonelected sequences. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20, 21, 26, 29 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 20, it is unclear what is meant by "functional sequence." Does the sequence need to have all of the functions of the specific SEQ ID NO, or just one or more of its function?

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20, 21, 26, 29 and 47 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant claims The claims are directed to a synthetic promoter comprising a sequence shown in SEQ ID NO: 7 or a functional sequence with at least 50% identity, SEQ ID NO: 18 or a functional sequence with at least 75% identity, SEQ ID NO: 5 or a functional sequence with at least 75% identity, SEQ ID NO: 2 or a functional sequence with at least 75% identity, SEQ ID NO: 12 or a functional sequence with at least 75% identity, SEQ ID NO: 4 or a functional sequence with at least 50% identity, SEQ ID NO: 13 or a functional sequence with at least 75% identity, SEQ ID NO: 14 or a functional sequence with at least 75% identity and SEQ ID NO: 16. The claims read on a broad genus of promoters and functional variants thereof.

The written description requirement for a genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice or by disclosure of relevant identifying characteristics, i.e. structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such

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identifying characteristics, sufficient to show applicants were in possession of the claimed invention. In the instant case, the specification does not sufficiently describe a representative number of promoter variants by actual reduction to practice or by disclosure of relevant identifying characteristics. In fact, the specification is silent as to any sequence identity for the promoters.

Applicant claims a promoter or promoter variant by function only, without any disclosed or known correlation between the elements and their function. The specification only provides teachings of the sequences comprising various domains of the promoter. The specification does not teach a promoter comprised of sequences that are a certain percent identity to the original sequences, i.e., the specification does not teach a promoter comprising a functional sequence with at least 50% identity to SEQ ID NO: 7, a functional sequence with at least 75% identity to SEQ ID NO: 18, SEQ a functional sequence with at least 75% identity to ID NO: 5, a functional sequence with at least 75% identity to SEQ ID NO: 2, a functional sequence with at least 75% identity to SEQ ID NO: 12, a functional sequence with at least 50% identity to SEQ ID NO: 4, a functional sequence with at least 75% identity to SEQ ID NO: 13, a functional sequence with at least 75% identity to SEQ ID NO: 14 and SEQ ID NO: 16. The skilled artisan cannot envision a sufficient number of embodiments of the instant invention from the instant specification because the specification only discloses a single combination of these sequences as represented by SEQ ID NO: 1. Also, applicants have not demonstrated that variance of 25%-50% of the nucleotides would result in a promoter that can function similarly.

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The state of the art at the time of filing does not provide sufficient information on the subject to overcome the deficiencies of the instant specification. There is no description in the art that allows one to envision a representative number of promoter variants by disclosing structural or functional features of promoters comprising variations of the sequences listed so that one of skill in the art could envision the claimed invention. Thus the skilled artisan cannot consult the art at the time of filing to envision a sufficient number of embodiments of the instant invention to see that the applicant was in possession of the claimed genus.

Given the large size and diverse nature of the recited sequences and the inability to determine which will also possess the ability to mediate expression, it is concluded that the invention must be empirically determined. As a result, the skilled artisan would not be able to envision the claimed invention. Therefore applicant has not satisfied the written description requirement to show the skilled artisan that they were in possession of the claimed genus.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,639,065. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993), *In re Longi*, 759 F.2d 887, 224 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 20 is generic to all that is recited in claim 2 of U.S. Patent No. 6,639,065. That is, claim 2 of U.S. Patent No. 6,639,065 falls entirely within the scope of claim 20, or in other words, claim 20 is anticipated by claim 2 of U.S. Patent No. 6,639,065. Specifically, a synthetic promoter comprising SEQ ID NOs: 7, 18, 5, 2, 12, 4, 13, 14 and 16 of claim 20 in the instant application includes the synthetic promoter of claim 2 of U.S. Patent No. 6,639,065. The open language of claim 20 allows for the combination of SEQ ID NOs: 7, 18, 5, 2, 12, 4, 13, 14 and 16 plus any additional sequences added. In other words, claim 20 is the genus of claim 2 of U.S. Patent No. 6,639,065. Therefore, claim 2 of U.S. Patent No. 6,639,065 falls entirely within the scope of claim 20, or in other words, claim 20 is anticipated by claim 2 of U.S. Patent No. 6,639,065.

### ***Allowable Subject Matter***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele K. Joike, Ph.D. whose telephone number is 571-272-5915. The examiner can normally be reached on M-F, 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel, Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michele K Joike, Ph.D.  
Examiner  
Art Unit 1636

  
DAVID GUZO  
PRIMARY EXAMINER